

Appl. No.: 10/817,365  
Art Unit: 3728 Docket No.: B04-11  
Reply to Office Action of August 18, 2005

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### **REMARKS**

Claims 1-12 and new claims 13-20 appear in this application for the Examiner's review and consideration. Claims 1, 7, and 8 have been amended.

Claim 1 has been amended to recite that the enclosure is formed from paper stock and that the top, bottom, and side portions of the box are held together by an adhesive or an equivalent. Support can be found in the Specification on page 3, line 21, and on page 3, lines 18-20.

New claims 13-20 have been added. Support for the new claims can be found in the Specification on page 9, lines 1-2 (claims 13-14); many locations, such as page 3, line 22 and Figure 2 (claim 15); page 9, lines 3-7 (claims 17-19); many locations, such as original claim 1, Figure 2, and page 3, lines 18-21 (independent claims 16 and 20).

No new matter has been added by these amendments and additions.

### **Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claim 6 was rejected under 35 U.S.C. § 112, second paragraph for allegedly citing trademarks or acronyms.

The terms CMYK, CMYKOG, RGB, and PMS are not trademarks. They are "Names Used in Trade," which is defined in M.P.E.P. § 608.01(v) as "a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer." The M.P.E.P. is clear that "[n]ames used in trade are permissible in patent applications if: (A) their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or (B) in this country, their meanings are well-known and satisfactorily defined in the literature."

In this case, the terms used in claim 6 are "established by an accompanying definition which is sufficiently precise and definite" and have meanings that are "well-known and satisfactorily defined in the literature." Referring to the Specification on page 4, line 30 through page 5, line 1, and on page 5, lines 10-12, "RGB" is defined as a 3-color system including red ("R"), green ("G"), and blue ("B"), "CMYK" is defined as a 4-color system including cyan ("C"), magenta ("M"), yellow ("Y"), and black ("B"), and "CMYKOG" is defined as a 6-color

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system adding the colors orange ("O") and green ("G") to the conventional CMYK color space. *See* Specification at page 4, line 30 through page 5, line 1; and page 5, lines 10-12. "PMS" is defined as Pantone Matching System. *See* Specification at page 5, lines 12-16.

Additionally, even absent these definitions, one of even ordinary skill in the art of printing and graphics would be well aware of the meanings of the industry standard terms CMYK, CMYKOG, RGB, and PMS, as they are all used on an everyday basis as part of the routine and unique terminology associated with the printing industry.

The rejection under 35 U.S.C. § 112, second paragraph, is therefore believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

#### **Rejection Under 35 U.S.C. § 103(a)**

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application Publication No. 2003/0168363 to Molitor.

The Molitor publication is generally "directed to a the use of overwraps, such as multi-layer overwraps, for packaging various arrangements of golf ball sleeves... eliminat[ing] the need for prior art boxes and cartons." *See* the '363 Publication at Paragraph [0002]. The overwrap is a polymeric or plastic multi-layer structure. The outer layer is typically formed from, for example, polyolefins (*i.e.*, polypropylene), acrylonitrile-butadiene-styrenes, acrylics, cellophane, cellulose, fluoropolymers, ionomers, polyamides, polycarbonates, polyesters, polyimides, polyethylenes, polystyrenes, vinyls, and polyurethanes. *See* the '363 Publication at Paragraph [0049]. Print indicia may be deposited, in reverse format, on the inner surface of the outer layer. The inner layer is also formed from a plastic or polymeric material and, additionally, includes a thin layer of metal or foil to mask visibility of any underlying material and to add strength to the overwrap packaging. *See* the '363 Publication at Paragraph [0050].

The multi-layer polymeric overwrap packaging described in Molitor is developed with the goal of "reduc[ing] packaging costs and time to complete the final product" and the desire "to eliminate one or more of these packaging components [boxes for retaining sleeves of golf balls and protective shrinkwrap] in order to reduce the overall process time." *See* the '363 Publication at Paragraph [0011]. This is not the present invention.

The present invention is a structurally-robust package that is formed from a two-dimensional material, such as paper stock, suitable for receiving a printed image of a business

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card. The two-dimensional material has discrete top, bottom, and side portions that, when brought together and held in place, form a three-dimensional enclosure, such as a box, for receiving golf balls.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Molitor reference does not teach or suggest all the limitations recited in independent claim 1 of the present invention. In particular, Molitor does not disclose, or even suggest, 1) that the enclosure is formed of a material suitable for printing thereon comprising paper stock; 2) a top, bottom, and plurality of side portions (the Molitor packaging is a wrap – it is entirely a single piece with no individual portions); 3) that the portions are held together by adhesive/glue or a structural manner (*i.e.*, tabs/slots or folds). In fact, Molitor states that “[p]referably, adhesive is not used to seal the ends...” of the packaging. “Instead, localized heat is preferably used to partially melt and bond...” the packaging to “...effectively seal the end of the resulting package.” See the ‘363 Publication at Paragraph [0045].

There is certainly no suggestion or motivation for the skilled artisan to modify Molitor's multi-layer, polymeric, overwrap packaging into the box described by the instant claims. Molitor actually states that boxes for encasing golf ball sleeves are bad, recommending that the skilled artisan eliminate boxes and pointing out that printing on boxes increases the cost of packaging and adds to the overall manufacturing time. See the ‘363 Publication at Paragraph [0009].

It is also well held that a *prima facie* case of obviousness can be rebutted if Applicant can show that the cited reference, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 43 U.S.P.Q.2d 1362, 1365 (Fed. Cir. 1997). Molitor describes a novel multi-layered polymeric overwrap packaging in an effort to “reduce packaging costs and time to complete the final product” and “to eliminate ... [boxes for retaining sleeves of golf balls] ... in order to reduce the overall process time.” See the ‘363 Publication at Paragraph

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[0011]. Therefore, Molitor *teaches away* from the present invention by prescribing the elimination of a box for containing golf balls, let alone one that is printed on or, more specifically, one containing the digital image of a business card.

The reference may further be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be led in a direction divergent from the path that was taken by Applicant. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999). One of ordinary skill in the art, reading Molitor, would certainly be led in a direction divergent from Applicant's path – they would be encouraged to replace Applicant's box with a multi-layered polymeric overwrap. Even if inidicia were printed on the multi-layer overwrap, this is not the invention described by Applicant.

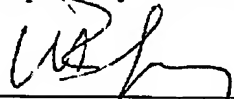
For at least the above reasons, the rejection under 35 U.S.C. § 103(a) is believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

### CONCLUSION

Based on the remarks set forth above, Applicant believes that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicant's attorney would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

No fee is believed to be due for this submission. Should any other required fees be due, however, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,



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